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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/638,159	08/07/2003	Ernest R. Chacon	13710-4001	3580

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ORRICK, HERRINGTON & SUTCLIFFE, LLP
IP PROSECUTION DEPARTMENT
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IRVINE, CA 92614-2558

EXAMINER

CHU, HELEN OK

ART UNIT	PAPER NUMBER
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1795

MAIL DATE	DELIVERY MODE
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10/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/638,159	Applicant(s) CHACON, ERNEST R.	
	Examiner Helen O. Chu	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7,8,11,12,14-17,20,21,23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7,8,11,12,14-17,20,21,23 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's Amendments have been received on August 13, 2007. Claims 7, 8, 11, 12, 14-17, 20 and 21 are amended. Claims 23 and 24 are new. Claims 9, 10, 13, 18, 19 and 22 are cancelled.
2. The text of those sections of Title 35, U.S.C. code not included in this action can be found in the prior Office Action.

Claim Rejections - 35 USC § 112

3. The rejections under 35 U.S.C. 112, first paragraph, on claims 7-22 are withdrawn because Applicant the claims.
4. The rejections under 35 U.S.C. 112, first paragraph, on claims 14, 16, 18, 20 are withdrawn because Applicant the claims.
5. The rejections under 35 U.S.C 112, second paragraph on claims 14, 16, 18, 20 are withdrawn because Applicant has amended the claims
6. The rejections under 35 U.S.C 112, second paragraph on claims 13 and 22 are withdrawn because the Applicant has amended the claims.

Claims Analysis

7. The structures of the claim limitation are given patentable weight, however, the functional claim language is not given patentable weight. Some examples of functional claim language includes:

Claims 7, 8, 11, 12, 14-17, 20, 21, 23, 24 recite "is adapted to substantially prevent conductive items from contacting the terminals on the battery."

Claim Rejections - 35 USC § 102

8. The rejections under 35 U.S.C 102(b), on claims 7-22, as anticipated by Takeno et al. are withdrawn because Applicants have amended the claims.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 15, 17, 21, 24 are rejected under 35 U.S.C. 102(b) as being unpatentable over Nishiyama et al. (US Patent 6,174,618).

The Nishiyama et al. reference discloses a battery holder made of ABS resin (Applicant's material for non-conductivity; Column 3, Lines 51) first and second sleeves, which have a terminal end and opened on the other end (Figure 8). The Nishiyama et al illustrates the diameter of the air apertures that pass through the first and second sleeve (Figure 1, Component 2d) are smaller than the diameters of the battery terminals and aligned to the first end of any battery terminals(Figure 1, Component 2b). The Nishiyama et al. reference disclose the length of the first sleeve being shorter than the length of the battery and the second sleeve being less than the length of the exposed end of the battery.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 7, 8, 11, 12, 14, 16, 20, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishiyama et al. (US Patent 6,174,618).

The Nishiyama et al. reference discloses a battery holder made of ABS resin (Applicant's material for non-conductivity; Column 3, Lines 51) cavities on the first and second sleeves, which have a terminal end and opened on the other end (Figure 8). The Nishiyama et al illustrates the diameter of the air apertures that pass through the first and second sleeve (Figure 1, Component 2d) are smaller than the diameters of the battery terminals and aligned to the first end of any battery terminals (Figure 1, Component 2b). The Nishiyama et al. reference disclose the length of the first sleeve being shorter than the length of the battery and the second sleeve being less than the length of the exposed end of the battery but does not disclose a second sleeve to be substantially equal in length of the said exposed end of said battery, however, it would have been obvious matter of design choice to make the second sleeve to be substantially as long as the exposed length of the battery, since such modification would have involved a mere change in size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. MPEP 2144.04 (IV)

It is noted that claims 7, 8, 11, 12, 14-16, 20, 21, 23, 24 have "intended use" language and it has been held that a recitation with respect to the manner in which a

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claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Response to Arguments

13. Applicant's arguments with respect to Takeno et al. reference have been considered but are moot in view of Applicant's amendments.

14. Applicant's arguments filed August 13, 2007 have been fully considered but they are not persuasive.

Applicant's principal arguments are:

A) *In contrast, the battery holes in Nishiyama are present to facilitate discharge of the batteries, which is the exact opposite of what happens with the claimed apertures.*

B) *The Office Action also states the first "sleeve" in Nishiyama is shorter than the length of the battery and that the second "sleeve" is less than the length of the exposed battery. Applicant submit that there are no sleeves in Nishiyama at all but rather a cap on each end of the battery that attaches the electrodes to the battery terminals while the rest of the battery is substantially exposed. In fact "Nishiyama states one of the aspects of the invention described therein was the "expose faces between the upper and lower support members.." Col.7, lines 65-*

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66. Together with the prior art description (col. 1, Lines 50-58), the Nishiyama reference teaches away from making a "sleeve" or any other type of case or apparatus from partially or fully covering the battery or batteries.

In response to Applicant's principal arguments, please consider the following.

A) The Applicants are arguing "intended use" of the claimed invention. It is noted that claims with "intended use" language and it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

B) These arguments are mere assertions of which the Applicants did not provide any evidence to support the arguments. Whether the claims recite a sleeve for a battery or whether the Applicants feel that the prior art is a cap for a battery is irrelevant. The prior art discloses a battery holder with the same structures of the Applicants invention, thus they are the same invention.

Please consider that the Applicants claimed recitation addresses a non-sealed relationship between the sleeves and therefore does not have the claimed recitation of a fully covered battery (Refer to Remarks/Arguments 35 U.S.C. 112 Rejection dated 8/13/2007) Furthermore, the Applicants battery holder are exposed on the side faces between the upper and lower support members please refer to Fig. 2, 4, 9 which is also equivalent to the disclosure of Nishiyama et al.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen O. Chu whose telephone number is (571) 272-5162. The examiner can normally be reached on Monday-Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HOC


TRACY DOVE
PRIMARY EXAMINER

10/07